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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	92078340
Party	Plaintiff Festivals of Speed, LLC
Correspondence address	DONALD J SCHUTZ SCHUTZ LITIGATION 535 CENTRAL AVENUE ST PETERSBURG, FL 33701 UNITED STATES Primary email: don@lawus.com Secondary email(s): donschutz@netscape.net 727-823-3222
Submission	Motion to Amend Pleading/Amended Pleading
Filer's name	Donald J Schutz
Filer's email	don@lawus.com
Signature	/Donald J Schutz/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re:

Registrations of The Goodwood Estate Company
Private Limited Company United Kingdom
Goodwood, Chichester, West Sussex PO 18 0PX United Kingdom

First Mark: GOODWOOD FESTIVAL OF SPEED

Registration Number 5557758
International Registration Number 1370233
Registration Date September 11, 2018

Second Mark: FESTIVAL OF SPEED

Registration Number 6132392
International Registration Number 1449837
Registration Date August 25, 2020

FESTIVALS OF SPEED, LLC, A Florida
Limited Liability Company,
Petitioner,

CANCELLATION NO.
92078340

v.

THE GOODWOOD ESTATE COMPANY
PRIVATE LIMITED COMPANY UNITED KINGDOM,
Registrant.

FIRST AMENDED PETITION FOR CANCELLATION OF REGISTERED TRADEMARKS

Festivals of Speed, LLC, a Florida limited liability company, Petitioner, with an address of 1217 Overlook Road, Eustis, FL 32726, and principal business address of 3501 West Old Highway 441, Mount Dora, Florida, 32757, originally formed on November 7, 2005 (“FOS” or “Petitioner”), now Petitions the United States Patent and Trademark Office (“USPTO”) to cancel the registration and registered trademarks, “GOODWOOD FESTIVAL OF SPEED,” USPTO Registration No. 5557758 (“Goodwood’s First Registration, “Goodwood Festival of Speed”) and “FESTIVAL OF SPEED,” USPTO Registration No. 6132392 (Goodwood’s Second Registration, “Festival of Speed”) (collectively, the “Goodwood Registrations”) and states:

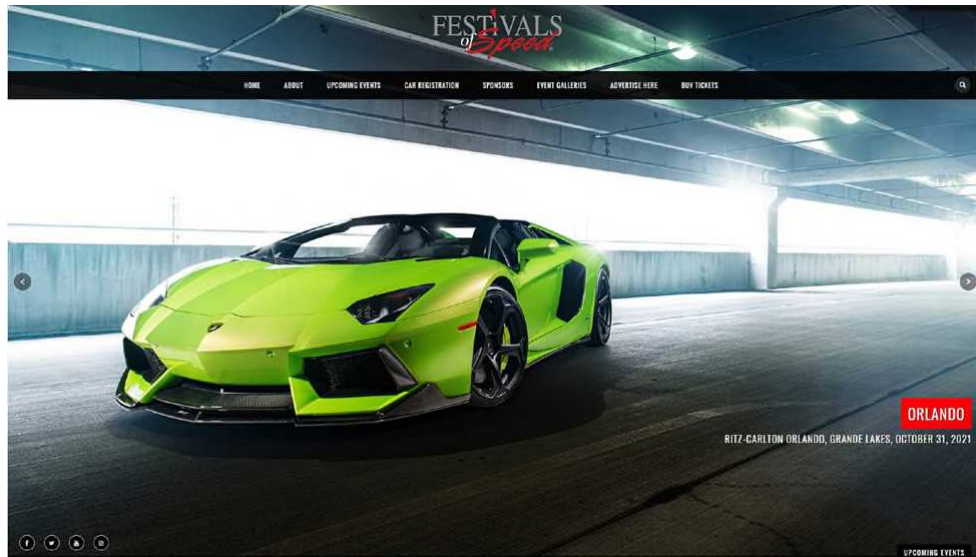
DESCRIPTION OF THE PETITIONER: FESTIVALS OF SPEED, LLC, A FLORIDA LIMITED LIABILITY COMPANY:

1. Petitioner is a Florida limited liability company and is listed in the records of the USPTO as the registrant of U.S. Registration No. 3665425 (the “FOS Registration”) of “FESTIVALS OF SPEED” (the “FOS Festivals of Speed Registration”), filing date of October 26, 2006, registration date of August 11, 2009, Sec. 15 and Sect. 8 (6-YR) and Section 8 (10-YR) issued September 29, 2018, in International Class 41, for:

Conducting entertainment exhibitions in the nature of shows and events featuring automobiles, motorcycles, aircraft, and watercraft

2. FOS was founded in 2004 and at inception held multiple events each year primarily in Florida, California, New York and other venues. The FOS events focused on, and currently focus on, events featuring automobiles, motorcycles, aircraft, equestrian and yachts. FOS events were and are held at such luxury venues as the Ritz-Carlton in Orlando, the Omni Amelia Island Plantation in Amelia Island, Florida, and the Renaissance Vinoy Hotel in St. Petersburg, Florida. The FOS events have not been, and are not, tied to any specific geographic location within the United States.

3. FOS published its website at www.festivalsofspeed.com and its design incorporating its word mark FOS Festivals of Speed Registration is shown on its current website (10/26/2021) as:

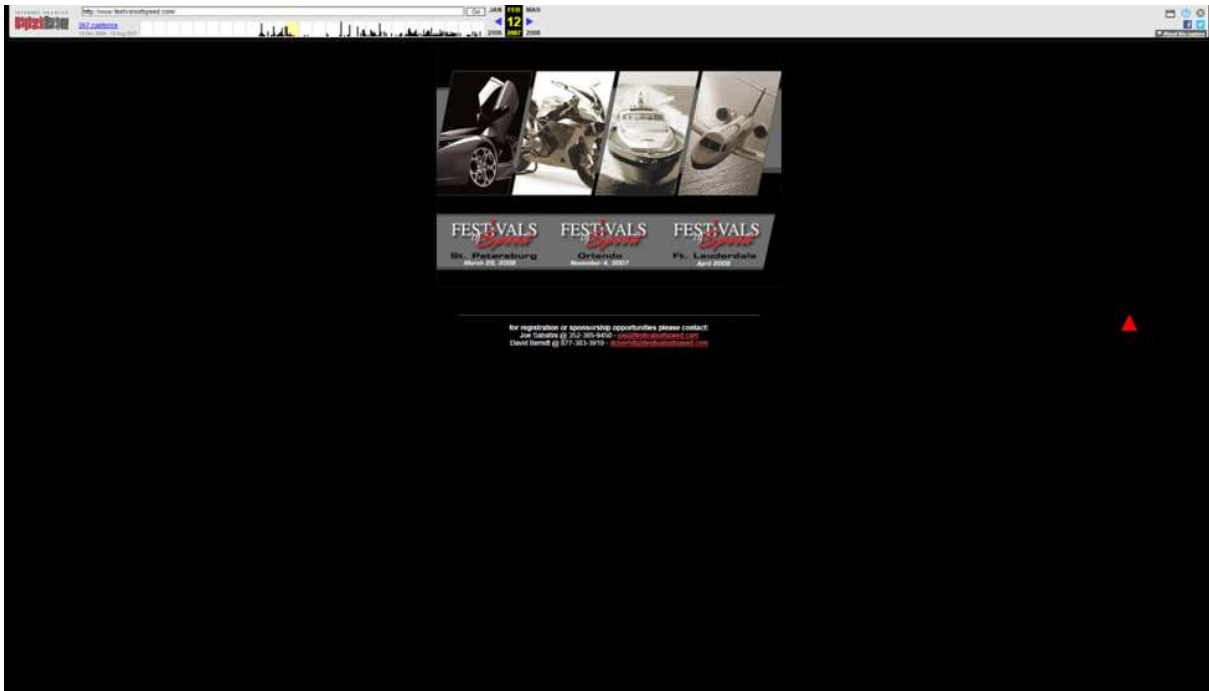


4. Since inception, FOS has used its FOS Festivals of Speed Registration in the United States for events featuring Equestrian and Horse events, Air Craft Displays (Vintage And Contemporary), Wine And Spirit Dinners, High End Food Events, Yacht Displays, Auto Displays, Motorcycles, Truck Displays, Event Magazine Printing And Design, E Newsletters, Apparel, Car Rally events and related and similar events.

5. FOS used its FOS Festivals of Speed Registration for automobiles, motorcycles, yachts, and airplanes, for example, the FOS website for February 12, 2007 as depicted on the Wayback Machine at:

<https://web.archive.org/web/20070212080851/http://www.festivalsofspeed.com/> featured luxury automobiles, motorcycles, yachts, and aircraft and featured three events for 2008 at St. Petersburg, Orlando, and Ft. Lauderdale, Florida:

<https://web.archive.org/web/20070212080851/http://www.festivalsofspeed.com/>



6. Since 2004, FOS has continually published its website, produced its events, and developed and exploited its FOS Festivals of Speed Registration within the United States. FOS has senior and priority use of the mark, “Festivals of Speed” as against the Respondent.

DESCRIPTION OF THE RESPONDENT: THE GOODWOOD ESTATE COMPANY PRIVATE LIMITED COMPANY UNITED KINGDOM

7. Respondent, THE GOODWOOD ESTATE COMPANY PRIVATE LIMITED COMPANY UNITED KINGDOM, is an entity organized in the United Kingdom, with an address of Goodwood, Chichester, West Sussex PO18 0PX UNITED KINGDOM (“Goodwood” or “Respondent”), and is listed in the records of the USPTO as the registrant of:

(a) U.S. Registration No. 5557758 of “GOODWOOD FESTIVAL OF SPEED” (“Goodwood’s First Registration, “Goodwood Festival of Speed”):

GOODWOOD FESTIVAL OF SPEED

(b) in the following classes:

i) International Class 9 for:

Downloadable electronic publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; apparatus for recording, transmission or reproduction of sound or images; blank magnetic data carriers, blank recording discs; blank carriers and storage media, namely, records, circuits, discs, wires, tapes, film, cassettes, cartridges, fibres, and cards, bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs, or information; software and programs and downloadable programs and computer programs for use in entertainment, training, and education, in the nature of online classes in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; electronic sports training and activity simulators; vehicle drive training and flight simulators; downloadable publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the Internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; virtual reality systems, comprising virtual reality software for playing computer games, virtual reality headsets, virtual reality glasses; computer chips; time and date stamping machines; parts and fittings for all the aforesaid goods;

ii) International Class 25 for:

Clothing, namely, robes, coats, gloves, shoes, headbands, neckties, overalls, overcoats, pants, scarves, shirts, skirts, sweaters; footwear; headwear, namely, hats and caps all for use in sports and leisure pursuits; ear muffs; mountaineering boot liners

iii) International Class 35 for:

Advertising and promotion of educational, cultural, and entertainment events, namely, motorsports events, golfing events, horse-racing events, country estate leisure pursuits events, and historic buildings events

iv) International Class 41 for:

Education services, namely, providing classes and seminars in the fields of social, political, and economic interest; providing of training in the field of motorsports; entertainment services in the nature of horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; organizing sporting and cultural activities for education or entertainment purposes, namely, motorsports, horse-racing, country estate leisure pursuits, and historic buildings events; training in the field of motorsports; providing facilities for holding sports events, festivals, and concerts; movie and film production services and television production services; provision of recreational and sporting facilities; publishing of books and magazines; entertainment services in the nature of personal appearances by movie stars and sports celebrities; organization and arrangement of events for entertainment purposes, namely, sporting events, races, sports competitions, shows, game shows, award ceremonies, sports tournaments, awards ceremonies, photography, motor racing and flying contests, art festivals, art galas, parties,

dances, balls, sports meets, concerts, recitals, roadshows, displays for entertainment, art and food fairs, musical performances; organizing cultural, entertainment, and recreation services in the nature of horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; organizing entertainment, cultural, and educational club services in the nature of horse shows and racing, motor vehicle driving exhibitions, air shows, flying competitions; holiday camp services in the nature of sports or entertainment services, namely, horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; operating lotteries and raffles; booking seats for entertainment events and shows; providing games via the Internet and computer networks; news syndication reporting; educational services in the nature of classes in outdoor education in the fields of horse shows and racing, motor vehicle driving and racing, air shows, flying competitions; offering racing circuits and race tracks for lease, hire, or rent; provision of race, racing, and show facilities; arranging the rental, hire, and leasing of educational, training, cultural, entertainment and sporting equipment, services and facilities for use in education, training, cultural, entertainment and sporting events and activities, namely, motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; information, advice, and consultancy relating to the aforesaid

(c) U.S. Registration No. 6132392 of “FESTIVAL OF SPEED” (“Goodwood’s Second Registration, “Festival of Speed”), which is the following design mark:



Goodwood derived this design by deleting the word “Good” and “Wood” from the black bars, and deleting the phrase “Goodwood Road Racing Company” from the oval space around the checkered center, which is the trademark it historically has used in the United Kingdom as described hereinafter but that it has not sought an extension of protection for in the U.S.:



Goodwood's Second Registration "Festival of Speed" (without the words "Good" or "Wood" or the phrase in the circle under the crown, "Goodwood Road Racing Company") is in the following classes:

i) International Class 9 for:

Downloadable electronic publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; storage media, namely, discs in the nature DVDs, audio and audiovisual tapes, exposed cinematographic film, audio and audiovisual cassettes, cartridges in the nature of audio and audiovisual cassettes, all bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs, and information featuring motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings

ii) International Class 25 for:

Clothing, namely, robes, coats, gloves, shoes, headbands, neckties, overalls, overcoats, pants, scarves, shirts, skirts, sweaters; footwear; headwear, namely, hats and caps all for use in sports and leisure pursuits

iii) International Class 35 for:

Advertising and promotion of educational, cultural, and entertainment events, namely, motorsports events, golfing events, horse-racing events, country estate leisure pursuits events and historic buildings events

8. Goodwood's First Registration, "Goodwood Festival of Speed" and Goodwood's Second Registration, "Festival of Speed" were both applications for the extension of protection of an international registration per the Madrid Protocol under Section 66(a) of the United States Trademark Act, 15 U.S.C. § 1141- 1141n ("§ 66 (a)"). Per 15 U.S.C. § 1141(5) (A)-(C), an application under

Section 66 (a) required Goodwood to file a declaration (the “§ 66 (a) Declaration”) that:

- (A) the applicant or holder has a bona fide intention to use the mark in commerce;
- (B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and
- (C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.

9. Goodwood filed and made the required § 66 (a) Declaration to the United States Patent and Trademark Office (“USPTO”), in a communication made and transmitted to and within the United States to the USPTO, for both Goodwood’s First Registration, “Goodwood Festival of Speed” and Goodwood’s Second Registration, “Festival of Speed” with actual knowledge that:

(a) FOS was using its Festivals of Speed trademark and that the use of Goodwood’s First Registration, “Goodwood Festival of Speed” for any events other than its historical event held at Goodwood House, Sussex, in the United Kingdom, and Goodwood’s Second Registration, “Festival of Speed” were in such near resemblance to FOS’ Festivals of Speed Trademark or the near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive, because:

- i) Goodwood knew that FOS was using the FOS Registration, “Festivals of Speed” that was confusingly similar to Goodwood’s Registrations;
- ii) Goodwood knew that FOS had superior rights to Goodwood in the use of the mark, “Festivals of Speed” or “Festival of Speed” by virtue of FOS’ use and FOS’ Registration;
- iii) Goodwood had no reasonable belief that there was no likelihood of

confusion that would result from Goodwood's use of the Goodwood Registrations;

- iv) Goodwood knew that Goodwood could obtain an extension of protection under § 66(a) without use that would be the equivalent of registration on the Principal Register, knew that it was not entitled to the registrations due to the likelihood of confusion with the FOS' marks, and made the § 66(a) Declarations with the knowledge and intent of the foregoing; and
 - v) Goodwood's Registrations did not constitute a "proper filing" as required by 11 U.S.C. § 1141f (b);
- (b) "[e]xtension of protection [under § 66 (a)] shall not be refused on the ground that the mark has not been used in commerce," per 15 U.S.C. § 1141h (a) (3), and as a result thereof, Goodwood knew that it had no obligation to actually use marks to obtain an extension of protection under § 66(a);
- (c) Per 11 U.S.C. § 1141f (b), the "proper filing" of the request for extension of protection constitutes constructive use of the mark as of the earliest of the date of recordal of the request for extension of protection or the date of priority claimed by Goodwood, and as a result thereof, Goodwood would be entitled to claim constructive use without any use;
- (d) Per 15 USCS § 1141i, extension of protection shall have the same effect and validity as registration on the Principal Register and "the holder of the international registration shall have the same rights and remedies as the owner of a registration on the Principal Register";
- (e) The holder of an extension of protection is required to file an affidavit stating

that the mark is in use in commerce during the one year period immediately preceding the expiration of 6 years following the issuance of certificate of extension, per 15 USCS § 1141k; and

- (f) The period for continuous use for incontestability begins on the date of the issuance of the certificate of extension of protection.

10. As of the filing of this First Amended Petition, the five-year period for the filing of an affidavit of use per 15 USCS § 1141k has not lapsed for the Goodwood Registrations and Goodwood has not yet filed an affidavit alleging use for either Goodwood's First Registration, "Goodwood Festival of Speed" or Goodwood's Second Registration, "Festival of Speed."

11. However, per 15 U.S.C. § 1141h (a) (4), extension of protection "shall be refused to any mark not registrable on the Principal Register." A § 66(a) registration is subject to the same grounds for cancellation as those registrations issued under Section 1 or Section 44(e).¹ The U.S. registration may be subject to cancellation even if the international registration remains valid and subsisting.² A registered extension of protection may be invalidated or revoked in whole or in part.³ "In the case of partial invalidation, the USPTO will not cancel the registered extension of protection but, instead, delete the relevant goods/services from the USPTO's electronic records for the registration. An updated registration certificate will not issue," and "the cancellation procedures . . . that result in an invalidation of a registered extension of protection are governed by the substantive and procedural law of the United States, and are the same as for national marks registered by the USPTO."⁴

12. The application for Goodwood's First Registration, "Goodwood Festival of Speed" identifies International Trade Mark No. 1131370233 (EUIPO) for "Goodwood Festival of Speed,"

¹ *Saddlesprings, Inc. v. Mad Croc Brands, Inc.*, 2012 TTAB LEXIS 378, at *9 (T.T.A.B. Sept. 25, 2012).

² *Sandro Andy, S.A. v. Light Inc.*, 2012 U.S. Dist. LEXIS 182401, at *5-6 (S.D.N.Y. Dec. 27, 2012).

³ TMEP § 1904.07.

⁴ TMEP § 1904.07

registered as a “word” mark, as the international registration upon which its Section 66 (a) application relies.

13. The application for Goodwood’s Second Registration, “Festival of Speed” lists UK Trade Mark No. UK00003301170 as the international mark upon which its Section 66(a) application relies, which is the design mark omitting the words “Good” and “Wood” in the black bars and the phrase “Goodwood Road Racing Company, as shown above in Paragraph 7 (c), Page 6, *supra*.

14. When Goodwood filed its application for Goodwood’s Second Registration, “Festival of Speed,” Goodwood originally applied for but subsequently voluntarily deleted International Class 41 during the registration process in response to a USPTO office action.

15. After obtaining registration of Goodwood’s Second Registration, “Festival of Speed” excepting IC Class 41, Goodwood unsuccessfully attempted a third registration with the same design as in Goodwood’s Second Registration, “Festival of Speed” above, also deleting the word “Goodwood,” USPTO Serial Number 79291294 (“Goodwood’s Refused IC 41 Attempt”), in which the USPTO issued a final refusal based on the conflict with Petitioner’s FOS Festivals of Speed Registration. Goodwood’s Refused IC 41 Attempt was for the same design mark above as Goodwood’s Second Festival of Speed Registration in International Class 41 as follows:

Education services, namely, providing classes and seminars in the fields of social, political, and economic interest; providing of training in the field of motorsports; entertainment services in the nature of horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; organizing sporting and cultural activities for education or entertainment purposes, namely, motorsports, horse-racing, country estate leisure pursuits, and historic building events; providing facilities for holding sports events, cultural festivals, and music concerts; movie and film production services and television show production services; provision of recreational and sporting facilities; publishing of books and magazines; entertainment services in the nature of personal appearances by movie stars and sports celebrities; organization and arrangement of events for entertainment purposes, namely, sporting events, races, sports competitions, art shows, game shows, sports tournaments, sports awards ceremonies, photography exhibitions, motor racing and flying contests, art festivals, art galas, parties, dances, balls, sports meets, music concerts, music recitals, roadshows, displays for entertainment, art and food fairs, musical performances; organizing cultural, entertainment, and recreation services in the nature of horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; organizing

entertainment, cultural, and educational club services in the nature of horse shows and racing, motor vehicle driving exhibitions, air shows, flying competitions; holiday camp services in the nature of sports and entertainment services, namely, horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; operating lotteries and raffles; booking seats for entertainment events and shows; entertainment services, namely, providing an on-line computer game via the internet and computer networks; news syndication reporting; educational services in the nature of classes in outdoor education in the fields of horse shows and racing, motor vehicle driving and racing, air shows, flying competitions; providing facilities for horse and motorsports racing circuits and race tracks for lease or rent; provision of horse and motorsports race, racing, and show facilities; rental of and leasing of educational, training, cultural, entertainment and sporting equipment and facilities for use in education, training, cultural, entertainment and sporting events and activities, namely, motorsports, golfing, horse-racing, country estate leisure pursuits, and historic building events; information, advice, and consultancy relating to the aforesaid

16. The design mark used for Goodwood's Second Registration, "Festival of Speed" was created and registered by Goodwood in the United Kingdom, for the purpose of filing the application for extension of protection for Goodwood's Second Registration, "Festival of Speed" under § 66 (a) and not for the purpose of using or developing the design mark in the United Kingdom.

17. Since 1993, and possibly longer, Goodwood has held at Goodwood House, West Sussex, England an annual event featuring vehicles and other events on the grounds of Goodwood House, West Sussex, England, known as "Goodwood Festival of Speed." The Goodwood Festival of Speed is named after, located in, and known by its geographical designation, "Goodwood," referring to the physical structure, "Goodwood House," which is a geographically based destination in the UK see, e.g., <https://www.goodwood.com/> and Wikipedia article at https://en.wikipedia.org/wiki/Goodwood_Festival_of_Speed The location, "Goodwood House," is located in a geographical area shown on Google Maps with multiple locations bearing the "Goodwood" geographic designation:



The location of Goodwood Festival of Speed is Goodwood House depicted below as located on the above map (photo at shutterstock_1260663826 shutterstock.com):



18. Goodwood’s use of its trademark “Goodwood Festival of Speed” prominently depicts the geographic identifier, “Goodwood,” as shown below (photo is shutterstock_1610561002 shutterstock.com):



19. On information and belief, Goodwood has never hosted an event outside of the geographical location of Goodwood House, West Sussex England, named either “Goodwood Festival of Speed,” or “Festival of Speed.” As published on the internet archiver Wayback Machine at <https://web.archive.org/web/20120525033948/http://www.goodwood.co.uk/festival-of-speed/welcome.aspx> as of May of 2012, Goodwood’s use of the Goodwood Festival of Speed Trademark in the United Kingdom always included the term, “Goodwood,” as shown below:





20. Although Goodwood’s First Goodwood Festival of Speed Registration with the USPTO is block letters shown below, Goodwood’s use of Goodwood’s First Registration, “Goodwood Festival of Speed” is in the above design and not the block letter registration of:

GOODWOOD FESTIVAL OF SPEED

21. Goodwood’s Second Registration, “Festival of Speed” is Goodwood’s UK design mark copied from its UK design in historical use but deleting reference to the word “Goodwood” from the above design mark. As of October 25, 2021, Goodwood continues to use the word “Goodwood” on the design mark from which Goodwood’s Second Registration, “Festival of Speed” is derived as published at <https://www.goodwood.com/motorsport/festival-of-speed/>:



22. Goodwood initially omitted the IC Class 41 filing from Goodwood's Second Registration, "Festival of Speed" and Goodwood first registered its design mark omitting the word, "Goodwood," in the United States only in classes 9, 25, and 35:



However, the international descriptions used by Goodwood to obtain its UK trademark are broad and encompassing, and the same are included in Goodwood's Second Registration, "Festival of Speed" logo, including:

A) In International Class 9 for:

Downloadable electronic publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; storage media, namely, discs in the nature DVDs, audio and audiovisual tapes, exposed cinematographic film, audio and audiovisual cassettes, cartridges in the nature of audio and audiovisual cassettes, all bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs, and information featuring motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings

B) International Class 25 for:

Clothing, namely, robes, coats, gloves, shoes, headbands, neckties, overalls, overcoats, pants, scarves, shirts, skirts, sweaters; footwear; headwear, namely, hats and caps all for use in sports and leisure pursuits

C) International Class 35 for:

Advertising and promotion of educational, cultural, and entertainment events, namely, motorsports events, golfing events, horse-racing events, country estate leisure pursuits events and historic buildings events.

23. Petitioner believes that Petitioner will be damaged by any use of Goodwood of Goodwood's First Registration, "Goodwood Festival of Speed" and Goodwood's Second Registration, "Festival of Speed" including as a result of a likelihood of confusion, blurring, or dilution, and therefore Petitions for the cancellation thereof.

24. Petitioner has prior and senior use of the mark "Festivals of Speed" in the United States, and Goodwood's Registrations are utilizing the exact verbiage of Petitioner's registered mark with the singular "festival" instead of the plural "festivals. This distinction is insufficient to avoid the likelihood of confusion.

25. Petitioner suffers injury in fact due to both Goodwood's First Registration, "Goodwood Festival of Speed" and Goodwood's Second Registration, "Festival of Speed" that is (a) concrete and particularized and (b) actual or imminent because Goodwood has begun enforcement of both Goodwood's Registrations as to third parties. Goodwood has not attempted to enforce trademarks against FOS.

26. Goodwood has filed both Goodwood's First Registration, "Goodwood Festival of Speed" and Goodwood's Second Registration "Festival of Speed" with no bona fide intention of using both marks in the United States for the five year period of incontestability without use, and thereafter, Goodwood intends to enforce the registered trademarks as incontestable marks even though Goodwood has made no use of the marks in the United States for the full five year period other than in connection with Goodwood's historical events held in the United Kingdom.

27. Upon the lapsing of the five-year time period to cancel Goodwood's Registrations, Goodwood will have the right to attempt to enforce its marks as incontestable marks. This Petition is filed within the five year period relating to both Goodwood Registrations.

28. Should the Goodwood Registrations not be cancelled or limited as requested herein, Petitioner FOS will be impaired in utilizing FOS' mark for such common activities as online

webpages in the form of magazines, labeling promotional flash drives with its design, broadcasting television and internet video content, selling clothing with the FOS designs, and related common advertising and expansion of the use of the FOS trademark. The specter of Goodwood's declaration of intent to use coupled with its Class 9, 25, 35, and 41 filings opens FOS to the specter of infringement litigation with Goodwood in broad categories of use by FOS of the FOS registered mark, "Festivals of Speed."

29. The impairment of FOS to freely utilize the FOS Festivals of Speed Registration without the specter of enforcement action by Goodwood is injury in fact that is concrete and particularized.

30. Should the Goodwood Registrations not be cancelled or limited as requested herein, Petitioner FOS is engaged in, or will likely engage in, activity that will give rise to a possible infringement claims by Goodwood. Goodwood's Registrations create the risk of interference with the rights that flow to FOS from registration of FOS' own mark. FOS will face the risk of potential trademark infringement liability for using FOS' own mark. In addition, if the Goodwood Registrations are not cancelled or limited, the very registration and use of the Goodwood Registrations will cause FOS harm.

31. Since Goodwood has deleted the geographic reference of "Goodwood" from Goodwood's Second Registration, "Festival of Speed" there is likelihood-of-confusion with the FOS Registration because Goodwood and FOS engage in the same line of business relating to events featuring automobiles, motorcycles, aircraft, and yachts, advertise to the same customers for events, engage the same or similar sponsors, and the failure to cancel Goodwood's Registrations will cause FOS competitive injury.

32. Goodwood first registered Goodwood's Second Registration, "Festival of Speed" trademark without the word, "Goodwood" and omitted Class 41, and only after that registration was

issued filed its third application to attempt to register Goodwood's design mark in Goodwood's Second Registration in International Class 41. As stated, the USPTO refused the third application.

33. Goodwood's intent is to engage in activity with Goodwood's Second Registration, "Festival of Speed" for goods and services that are, in reality, defined within Class 41 even though Goodwood cannot achieve trademark registration within class 41 and intends to compete with FOS under the guise of its Class 9, 25, and 35 registrations in Goodwood's Second Registration, "Festival of Speed."

34. This Petition is filed within five years of the registration of both marks this Petition seeks to cancel and all conditions precedent have occurred or been waived.

35. Petitioner FOS has and will be damaged by the continued registration of the Respondent Goodwood's Marks, as there is a likelihood of confusion by Goodwood's use of Goodwood's First Registration, "Goodwood Festival of Speed" and Goodwood's Second Registration, "Festival of Speed" in the United States.

**COUNT ONE: CANCELLATION OF GOODWOOD'S FIRST REGISTRATION,
"GOODWOOD FESTIVAL OF SPEED"**

36. This is a Petition for cancellation of Goodwood's First Registration, "Goodwood Festival of Speed."

37. Petitioner realleges and incorporates herein Paragraph's 1-35.

38. Goodwood's First Registration, "Goodwood Festival of Speed," is subject to cancellation because per 15 U.S.C. § 1141h (a) (4), extension of protection "shall be refused to any mark not registrable on the Principal Register" and is subject to cancellation as aforesaid stated.

39. Goodwood's First Registration, "Goodwood Festival of Speed" is not registrable on the Principal Register as follows:

A. International Class 9 for Electrical and Scientific Apparatus should be cancelled.

International Class 9 is for goods only, not services, and is only for an apparatus. “[I]nternational trademark class 9, . . . encompasses, inter alia, electrical and scientific apparatus such as calculating machines, data processing equipment and computers.”⁵ The Goodwood First Registration, “Goodwood Festival of Speed” for Class 9 Protection includes goods and services that are not properly included under Class 9 as described hereinafter and have otherwise never been used and/or have been abandoned, as follows, and are not properly within IC Class 9 and are therefore not registerable on the Principal Register per 15 U.S.C. § 1141h (a) (4). Goodwood describes its Class 9 goods and services as:

1. “Downloadable electronic publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings;”

As to this description of goods and services:

- (i) This registration under Class 9 is designed to appropriate fields of entertainment and events as opposed to the apparatus itself and is not registrable on the Principal Register and should be cancelled.
 - (ii) Goodwood’s use of Goodwood’s First Registration, “Goodwood Festival of Speed” for said goods and services in the United States in reference to any goods and services other than Goodwood’s historical event in the United Kingdom will cause damage to the Petitioner as there is a likelihood of confusion and Goodwood’s use will damage, dilute, and impair Petitioner’s use of its mark.
2. “[A]pparatus for recording, transmission or reproduction of sound or images; blank magnetic data carriers, blank recording discs; blank carriers and storage media, namely, records, circuits, discs, wires, tapes, film, cassettes, cartridges, fibres, and cards, bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs, or information;”

As to this description of claims:

⁵ *Primepoint, L.L.C. v. Primepay, Inc.*, 545 F. Supp. 2d 426, 430 (D.N.J. 2008).

- (i) Goodwood has never manufactured blank data carriers or the remaining goods under Goodwood's First Registration, "Goodwood Festival of Speed," mark;
 - (ii) Goodwood had no bona fide intention to use Goodwood's First Registration, "Goodwood Festival of Speed" at the time of Goodwood's § 66 (a) Declaration, for said goods and further made such claim through actual fraud as Goodwood (a) knew that the representations were false when made and said false representations were material to the application (b) made the representations for the purpose of obtaining Goodwood's First Registration, "Goodwood Festival of Speed" for this class of Goods and knew that it was not entitled to said registration;
 - (iii) Goodwood has never used Goodwood's First Registration, "Goodwood Festival of Speed," in commerce for this description of goods anywhere including but not limited to the United States, and has not used said Registration in commerce in the United States for more than three years following registration on September 11, 2018 and cancellation is appropriate pursuant to 15 U.S.C. § 1064 (6); and
 - (iv) Goodwood's First Registration, "Goodwood Festival of Speed," for this class of goods and services has never been used or in the alternative, any use has been abandoned and Goodwood has no intention to use said Registration for said goods in the future.
3. "[S]oftware and programs and downloadable programs and computer programs for use in entertainment, training, and education, in the nature of online classes in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; electronic sports training and activity simulators;

IC Class 9 does not protect the type of content on an apparatus, but instead, is for the apparatus itself. This registration under Class 9 is designed to appropriate fields of entertainment as

opposed to the apparatus itself, and is not registrable on the Principal Register and should be cancelled. In addition, as to this description of claims:

- (i) Goodwood's use of Goodwood's First Registration, "Goodwood Festival of Speed" for said goods and services in the United States in reference to any goods and services other than Goodwood's historical event in the United Kingdom will cause damage to the Petitioner as there is a likelihood of confusion and Goodwood's use will damage, dilute, and impair Petitioner's use of its mark;
 - (ii) Goodwood has never used Goodwood's First Registration, "Goodwood Festival of Speed," in commerce for this description of goods anywhere including but not limited to the United States, and has not used said Registration in commerce in the United States for more than three years following registration on September 11, 2018 and cancellation is appropriate pursuant to 15 U.S.C. § 1064 (6); and
 - (iii) Goodwood's First Registration, "Goodwood Festival of Speed," for this class of goods and services has never been used or in the alternative, any use has been abandoned and Goodwood has no intention to use said Registration for said goods in the future.
4. [D]ownloadable publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the Internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; virtual reality systems, comprising virtual reality software for playing computer games, virtual reality headsets, virtual reality glasses; computer chips; time and date stamping machines; parts and fittings for all the aforesaid goods

IC Class 9 does not protect the type of content on an apparatus, but instead, is for the apparatus itself. This registration under Class 9 is designed to appropriate fields of entertainment as opposed to the apparatus itself, and is not registrable on the Principal Register and should be cancelled.

Goodwood's use of Goodwood's First Registration, "Goodwood Festival of Speed" for said goods and services in the United States in reference to any goods and services other than Goodwood's historical event in the United Kingdom will cause damage to the Petitioner as there is a likelihood of confusion and Goodwood's use will damage, dilute, and impair Petitioner's use of its mark.

B. International Class 25 for Clothing Should Be Cancelled.

Goodwood's First Goodwood Festival of Speed Registration for Class 25, "clothing," is for

Clothing, namely, robes, coats, gloves, shoes, headbands, neckties, overalls, overcoats, pants, scarves, shirts, skirts, sweaters; footwear; headwear, namely, hats and caps all for use in sports and leisure pursuits; ear muffs; mountaineering boot liners

Goodwood's use of its Registered Trademarks in relation to clothing are as advertisement of the Goodwood Festival of Speed brand and not the clothing itself. There is no "Goodwood Festival of Speed" clothing line where the clothing, itself, is trademarked for the purpose of identifying the quality or source of goods as coming from Goodwood. Instead, the use of the trademark is to advertise and associate the wearer with the event. This is abandonment of the trademark for the purpose of Class 25. Goodwood does not, and has no intention to, use Goodwood's First Registration, "Festival of Speed," for clothing for the purpose of identifying the quality or source of the clothing as coming from Goodwood.

As to this description of claims:

- (i) Goodwood's use of Goodwood's First Registration, "Goodwood Festival of Speed" for said goods and services in the United States in reference to any goods and services other than Goodwood's historical event in the United Kingdom will cause damage to the Petitioner as there is a likelihood of confusion and Goodwood's use will damage, dilute, and impair Petitioner's use of its mark;

- (ii) Goodwood had no bona fide intention to use Goodwood's First Registration, "Goodwood Festival of Speed" at the time of Goodwood's § 66 (a) Declaration, for said goods and further made such claim through actual fraud as Goodwood (a) knew that the representations were false when made and said false representations were material to the application and ((b) made the representations for the purpose of obtaining Goodwood's First Registration, "Goodwood Festival of Speed" for this class of Goods and knew that it was not entitled to said registration;
- (iii) Goodwood has never used Goodwood's First Registration, "Goodwood Festival of Speed," in commerce for this description of goods anywhere including but not limited to the United States, and has not used said Registration in commerce in the United States for more than three years following registration on September 11, 2018 and cancellation is appropriate pursuant to 15 U.S.C. § 1064 (6); and
- (iii) Goodwood's First Registration, "Goodwood Festival of Speed," for this class of goods and services has never been used or in the alternative, any use has been abandoned and Goodwood has no intention to use said Registration for said goods in the future.

C. International Class 35 for Advertising; Business management; Business Administration; Office functions Should be Cancelled.

Goodwood claims trademark rights in Class 35 as:

Advertising and promotion of educational, cultural, and entertainment events, namely, motorsports events, golfing events, horse-racing events, country estate leisure pursuits events, and historic buildings events

Class 35 protects advertising services business administration, and office. "International Class 35 trademarks include services rendered with the objective of helping "in the management of the business affairs or commercial functions of an industrial or commercial enterprise." Nice Classification § 35 n.2"⁶.

⁶ *Workforce Software, LLC v. Workforce, Inc.*, No. 20 C 7365, 2021 U.S. Dist. LEXIS 206155, at *4 (N.D. Ill. Oct. 26, 2021).

Goodwood does not have the intention to offer services with the objective of helping in the management of business affairs under the “Goodwood Festival of Speed” name.

Goodwood’s use of Goodwood’s First Registration, “Goodwood Festival of Speed” for said goods and services in the United States in reference to any goods and services other than Goodwood’s historical event in the United Kingdom will cause damage to the Petitioner as there is a likelihood of confusion and Goodwood’s use will damage, dilute, and impair Petitioner’s use of its mark.

Goodwood had no bona fide intention to use Goodwood’s First Registration, “Goodwood Festival of Speed” at the time of Goodwood’s § 66 (a) Declaration, for said goods and further made such claim through actual fraud as Goodwood (a) knew that the representations were false when made and said false representations were material to the application (b) made the representations for the purpose of obtaining Goodwood’s First Registration, “Goodwood Festival of Speed” for this class of Goods and knew that it was not entitled to said registration;;

- (i) Goodwood has never used Goodwood’s First Registration, “Goodwood Festival of Speed,” in commerce for this description of goods and services anywhere including but not limited to the United States, and has not used said Registration in commerce in the United States for more than three years following registration on September 11, 2018 and cancellation is appropriate pursuant to 15 U.S.C. § 1064 (6); and
- (ii) Goodwood’s First Registration, “Goodwood Festival of Speed,” for this class of goods and services has never been used or in the alternative, any use has been abandoned and Goodwood has no intention to use said Registration for said goods in the future.

D. International Class 41 for Education; providing of training; entertainment; sporting and cultural activities should be limited or cancelled.

Petitioner FOS and Respondent Goodwood both primarily function within International Class 41 in the production of events relating to motorsports, yachting, equestrian, motorcycles, and airplanes. All of the use of the registered marks by both Petitioner FOS and Respondent Goodwood ultimately relate to Class 41 goods and services.

Goodwood's First Registration, "Goodwood Festival of Speed" has been used in the United States to date by Goodwood solely and exclusively referring to Goodwood's geographically identified event at Goodwood House, United Kingdom. Goodwood has never used, and has no intention to use, Goodwood's First Registration, "Goodwood Festival of Speed" other than for events at its historic location in the United Kingdom. To the extent that Goodwood claims to have a Section 66(a) right to utilize its international mark to hold events within the United States under the "Goodwood Festival of Speed" brand, the Registration should be cancelled.

As to this description of claims:

- (i) Goodwood had no bona fide intention to use Goodwood's First Registration, "Goodwood Festival of Speed" at the time of Goodwood's § 66 (a) Declaration, for said goods and services and further made such claim through actual fraud as Goodwood (a) knew that the representations were false when made and said false representations were material to the application and (b) made the representations for the purpose of obtaining Goodwood's First Registration, "Goodwood Festival of Speed" for this class of Goods and knew that it was not entitled to said registration;
- (ii) Goodwood has never used Goodwood's First Registration, "Goodwood Festival of Speed," in commerce for any goods and services other than Goodwood's historic event in the United Kingdom, in conjunction with goods and services, including but not limited to the United States, and has not used said Registration in commerce in the United States for more than three years following registration on September 11,

2018 for any goods and services other than Goodwood's historic event in the United Kingdom, and cancellation is appropriate pursuant to 15 U.S.C. § 1064 (6) for all goods and services other than Goodwood's historic event in the United Kingdom;

- (iii) Goodwood's First Registration, "Goodwood Festival of Speed," for this class of goods and services in the United States in reference to any goods and services other than Goodwood's historical event in the United Kingdom has never been used or in the alternative, any use has been abandoned and Goodwood has no intention to use said Registration for said goods in the future; and
- (iv) Goodwood's use of Goodwood's First Registration, "Goodwood Festival of Speed" for IC Class 41 goods and services in the United States in reference to any goods and services other than Goodwood's historical event in the United Kingdom will cause damage to the Petitioner as there is a likelihood of confusion and Goodwood's use will damage, dilute, and impair Petitioner's use of its mark.

Wherefore; Petitioner requests the Cancellation and/or Limitation of Goodwood's First Registration, "Goodwood Festival of Speed" as stated above, and for such other relief as deemed appropriate.

**COUNT TWO: CANCELLATION OF GOODWOOD'S SECOND REGISTRATION,
"FESTIVAL OF SPEED"**

40. This is a Petition for cancellation of Goodwood's Second Registration, "Festival of Speed."

41. Petitioner realleges and incorporates herein Paragraphs 1-35.

42. Goodwood's Second Registration, "Festival of Speed," should be cancelled because per 15 U.S.C. § 1141h (a) (4), extension of protection "shall be refused to any mark not registrable on the Principal Register" and is subject to cancellation as aforesaid stated.

43. Goodwood's Second Registration, "Festival of Speed" is not registrable on the Principal Register as follows:

A. International Class 9 for Electrical and Scientific Apparatus should be cancelled.

International Class 9 is for goods only, not services, and is only for an apparatus.

"[I]nternational trademark class 9, . . . encompasses, inter alia, electrical and scientific apparatus such as calculating machines, data processing equipment and computers"⁷. The Goodwood First Registration, "Goodwood Festival of Speed" for Class 9 Protection includes goods and services that are not protectible under Class 9 as described hereinafter and have otherwise never been used and/or have been abandoned, as follows, and are not properly within IC Class 9 and are therefore not registerable on the Principal Register per 15 U.S.C. § 1141h (a) (4):

"Downloadable electronic publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings;"

Goodwood's registration under Class 9 is designed to appropriate fields of entertainment as opposed to the apparatus itself, and is not registrable on the Principal Register and should be cancelled.

Goodwood's use of Goodwood's Second Registration, "Festival of Speed" for said goods and services in the United States will cause damage to the Petitioner as there is a likelihood of confusion and Goodwood's use will damage, dilute, and impair Petitioner's use of its mark.

B. International Class 25 for Clothing Should Be Cancelled.

Goodwood's Second "Festival of Speed Registration" for Class 25, "clothing," is for

Clothing, namely, robes, coats, gloves, shoes, headbands, neckties, overalls, overcoats, pants, scarves, shirts, skirts, sweaters; footwear; headwear, namely, hats and caps all for use in sports and leisure pursuits

⁷ *Primepoint, L.L.C. v. Primepay, Inc.*, 545 F. Supp. 2d 426, 430 (D.N.J. 2008).

Goodwood's use of its Registered Trademarks in relation to clothing are as advertisement of the Goodwood Festival of Speed brand and not the clothing itself. There is no "Goodwood Festival of Speed" clothing line where the clothing, itself, is trademarked for the purpose of identifying the quality or source of goods as coming from Goodwood. Instead, the use of the trademark is to advertise and associate the wearer with the event. This is abandonment of the trademark for the purpose of Class 25.

As to this description of claims:

- (i) Goodwood had no bona fide intention to use Goodwood's Second Registration, "Festival of Speed" at the time of Goodwood's § 66 (a) Declaration, for said goods and further made such claim through actual fraud as Goodwood (a) knew that the representations were false when made and said false representations were material to the application and (b) made the representations for the purpose of obtaining Goodwood's Second Registration, "Festival of Speed" for this class of Goods and knew that it was not entitled to said registration; and
- (ii) Goodwood's Second Registration, "Goodwood Festival of Speed," for this class of goods and services has never been used or in the alternative, any use has been abandoned and Goodwood has no intention to use said Registration for said goods in the future; and
- (iii) Goodwood's use of Goodwood's Second Registration, "Goodwood Festival of Speed" for said goods and services in the United States will cause damage to the Petitioner as there is a likelihood of confusion and Goodwood's use will damage, dilute, and impair Petitioner's use of its mark.

C. International Class 35 for Advertising; Business management; Business Administration; Office functions Should be Cancelled.

Goodwood claims trademark rights in International Class 35 as:

Advertising and promotion of educational, cultural, and entertainment events, namely, motorsports events, golfing events, horse-racing events, country estate leisure pursuits events and historic buildings events.

Class 35 protects advertising services business administration, and office. It is not a substitute for a Class 41 registration of the event name itself. “International Class 35 trademarks include services rendered with the objective of helping “in the management of the business affairs or commercial functions of an industrial or commercial enterprise.” Nice Classification § 35 n.2.”⁸ Goodwood does not offer, and has no intention to offer, services with the objective of helping in the management of business affairs under the “Festival of Speed” name.

As to this description of claims:

- (i) Goodwood had no bona fide intention to use Goodwood’s Second Registration, “Festival of Speed” at the time of Goodwood’s § 66 (a) Declaration, for said goods and services, and further made such claim through actual fraud as Goodwood (a) knew that the representations were false when made and said false representations were material to the application and (b) made the representations for the purpose of obtaining Goodwood’s Second Registration, “Goodwood Festival of Speed” for this class of Goods and knew that it was not entitled to said registration;
- (ii) Goodwood’s Second Registration, “Festival of Speed,” for this class of goods and services has never been used or in the alternative, any use has been abandoned and Goodwood has no intention to use said Registration for said goods in the future; and
- (iii) Goodwood’s use of Goodwood’s Second Registration, “Festival of Speed” for said goods and services in the United States in reference to any goods and services will cause damage to the Petitioner as there is a likelihood of confusion and Goodwood’s use will damage, dilute, and impair Petitioner’s use of its mark.

⁸ *Workforce Software, LLC v. Workforce, Inc.*, No. 20 C 7365, 2021 U.S. Dist. LEXIS 206155, at *4 (N.D. Ill. Oct. 26, 2021)

Wherefore; Petitioner requests the Cancellation of Goodwood's Second Registration, "Festival of Speed" as stated above, and for such other relief as deemed appropriate.

COUNT THREE
CANCELLATION OF GOODWOOD'S SECOND REGISTRATION, "FESTIVAL OF SPEED" OBTAINED THROUGH FRAUD

44. This is a Petition to cancel Goodwood's Second Registration, "Festival of Speed" on the basis that the United States extension of protection registration was obtained fraudulently and is subject to cancellation pursuant to 15 U.S.C. § 1064 (3).

45. Petitioner incorporates paragraphs 1-35 by reference.

46. Trademark applications in the United Kingdom are governed by the Trade Marks Act of 1994 of the United Kingdom, ("UK TMA") which provides, in pertinent part, that "[a] trade mark shall not be registered if it is (a) contrary to public policy or to accepted principles of morality", *Id.*, Sec. 3 (3) (a), and "[a] trade mark shall not be registered if or to the extent that the application is made in bad faith," *Id.*, Sec. 3 (6).

47. The registration of a trade mark under the UK TMA may be declared invalid on the ground that the trade mark was registered in breach of Section 3, *Id.*, Sec. 47.

48. As provided by Section 32, *Id.*, to register a trademark in the United Kingdom:

The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.

49. Goodwood filed its application for UK Trade Mark No. UK00003301170, which would later become the basis for Goodwood's Second Registration, "Festival of Speed" under which its Section 66(a) application relies, which is the design mark omitting the word "Good" on the left black bar, omitting the word "Wood" on the right black bar, and omitting the phrase, "Goodwood Road Racing Company as shown above and as shown below:



In comparison, Goodwood's historical mark as used in the United Kingdom is:



50. At the time of filing its application for UK Trade Mark No. UK00003301170, upon which it based Goodwood's Second Registration, "Festival of Speed," Goodwood falsely represented in the application filed in the United Kingdom that Goodwood was either using or had the bona fide intention to use the mark in the United Kingdom, that representation was knowingly false when made, and Goodwood thereby obtained its UK Trade Mark No. UK00003301170 in bad faith and in contravention of public policy and accepted principles of morality in violation of the provisions of the UK TMA. Goodwood's sole and exclusive intention in registering UK Trade Mark No. UK00003301170 was to file a Section 66 (a) application for extension of protection in the United States and thereby gain the advantages of registration on the Principal Register of the USPTO without any use or any bona fide intention to use said mark in the United Kingdom, and further, to be able to gain incontestability of the mark in the United States after the passage of five

years without bona fide use. As a result, Goodwood had actual knowledge at all times that its mark “shall not be registered” in the United Kingdom per UK TMA Sec. 3 and had actual knowledge that Goodwood’s Second Registration, “Festival of Speed” was not entitled to extension of protection under § 66 (a).

51. Goodwood’s UK Registration UK00003301170 is deceptive because it omits the word “Goodwood” from its historic design mark solely to create a registered UK mark for the purpose of claiming a subsisting trademark in the UK and solely for the purpose of applying for an extension of protection pursuant to § 66 (a) in the United States and is therefore not the actual trademark under which Goodwood has developed common law rights in the United Kingdom or otherwise properly registrable in the United Kingdom.

52. Goodwood had no intention when registering UK Registration UK00003301170 to use Goodwood’s Second Registration, “Festival of Speed” in the United Kingdom.

53. Goodwood has never used Goodwood’s Second Registration, “Festival of Speed” in the United Kingdom.

54. When Goodwood filed with the USPTO its § 66(a) application for extension of protection for its UK Trade Mark No. UK00003301170, Goodwood had actual knowledge that it had registered UK Trade Mark No. UK00003301170 with no intent to use the mark in the United Kingdom, but instead, intended only to apply for an extension of protection for the mark under the Madrid Protocol pursuant to § 66 (a) in the United States and thereby obtain the benefits of registration on the Principal Register of the United States and the ability to obtain incontestability without ever using the mark in the United States.

55. When filing its § 66(a) application, Goodwood knew that it had obtained its UK Trade Mark No. UK00003301170 in bad faith and in contravention of the application requirements of the UK TMA and therefore knew that said mark was not validly subsisting within the United

Kingdom. However, Goodwood knowingly falsely represented to the USPTO within the United States that its UK Trade Mark No. UK00003301170 was valid and subsisting and therefore knowingly falsely represented to the USPTO within the United States that said mark was not obtained in bad faith, knowingly falsely represented to the USPTO within the United States that its UK Trade Mark No. UK00003301170 was not contrary to public policy or to accepted principles of morality, and knowingly falsely represented to the USPTO within the United States that its UK Trade Mark No. UK00003301170 was not subject to absolute cancellation in the United Kingdom. Goodwood made such false representations knowingly, the representations were of material facts relating to the § 66(a) application, and the false representations of material fact were made with the intent and purpose of obtaining the § 66(a) registration for which it was otherwise not entitled.

56. Goodwood's false representations were made to the USPTO, within the United States, and were transmitted by means of wire, radio, or television communication within the United States and through and in United States interstate commerce.

57. By taking the foregoing action, Goodwood's Second Registration, "Festival of Speed" was obtained fraudulently and is subject to cancellation pursuant to 15 U.S.C. § 1064 (3).

58. The USPTO has jurisdiction to determine whether Goodwood obtained its United States extension of protection under § 66 (a) fraudulently, which includes a determination of whether Goodwood's Second Registration, "Festival of Speed," was based on a fraudulently obtained UK registration that shall not be registered under the UK TMA and is therefore not entitled to an extension of protection under § 66 (a).

59. For the foregoing reasons, UK Registration UK00003301170 (Goodwood's Second Registration, "Festival of Speed") is not a qualifying international trademark under Section 66(a), Goodwood's Second Registration, "Festival of Speed" was obtained through actual fraud, and should be cancelled.

Wherefore; Petitioner petitions for the cancellation of Goodwood's Second Registration, "Festival of Speed," and such other relief as deemed appropriate.

COUNT FOUR
CANCELLATION OF GOODWOOD'S REGISTRATIONS AS CAUSING A
LIKELIHOOD OF CONFUSION

60. Petitioner incorporates Paragraphs 1-35 by reference.

61. Petitioner is the prior and senior user in the United States of the mark "Festivals of Speed" to the Respondent Goodwood.

62. Goodwood's First Registration, "Goodwood Festival of Speed" prominently depicts the phrase "festival of speed" as a significant constituent component of the mark.

63. As applied to Goodwood's historic event at Goodwood House in the United Kingdom, Petitioner does not contend that the Registration causes confusion as Petitioner does not promote events in the United Kingdom and as long as Goodwood's continued use of Goodwood's First Registration, "Goodwood Festival of Speed" is in conjunction with its historic event geographically located in Goodwood, Sussex, United Kingdom. However, to the extent that the mark is not limited to events in the United Kingdom, the mark will result in a likelihood of confusion and damage to the Petitioner.

64. Goodwood's Second Registration, "Festival of Speed" as a logo mark, was registered for the purpose of promoting the "festival of speed" mark in the United States disconnected from the historic use of the mark only as to Goodwood's event promoted solely within the United Kingdom. The mark is confusingly similar as it only varies by one letter, that is, "festival," singular, instead of Petitioner's use of the plural, "festivals," and the use of the exact name for competing events results in a likelihood of confusion that will damage the Petitioner.

65. Goodwood's promotion of events of the same depiction and category of Petitioner FOS' events, including automobile, equestrian, yachts, aircraft, and motorcycle events, creates the

likelihood of confusion in mind of purchasing public as to whether the event is being promoted by Petitioner FOS or Respondent Goodwood due to the confusingly similar marks that will be sold through similar channels to same class of purchasers.

66. The goods and services described in Goodwood's Registrations explicitly show that Goodwood intends on head-to-head competition with the Petitioner by use of Goodwood's Second Registration, "Festival of Speed" in the area of events relating to automobiles, motorcycles, yachts, aircraft, and equestrian events, and by Goodwood's third Refused IC 411 Attempt.

67. Goodwood filed Goodwood's First Goodwood Festival of Speed Registration as a precursor to filing Goodwood's Second Festival of Speed Registration, which in turn was filed as a precursor to the filing of Goodwood's Refused IC 41 Attempt. All of these filings were for the purpose of ultimately registering a "festival of speed" mark to impair, dilute, and limit FOS' use and expansion of the FOS Festivals of Speed Registration.

68. In Goodwood's First Goodwood Festival of Speed Registration the word "Goodwood," means and refers to Goodwood House, Sussex. Accordingly, the consuming public is aware that Goodwood's UK registration, and Goodwood's First Registration, "Goodwood Festival of Speed," relates only to the event at Goodwood, Sussex, in the United Kingdom. Any use within the United States for events promoted by Goodwood through the use of both Goodwood Registrations create a likelihood of confusion.

69. FOS has developed its trademark and intends to naturally expand the use of the FOS mark into areas encompassed within Goodwood's descriptions of its use in International Classes 9, 25, and 35, and Goodwood should not be allowed to register its international mark in the United States without any use in either the United Kingdom or the United States and obtain the benefits of registration on the principal register for any use other than the use of Goodwood's First Registration, "Goodwood Festival of Speed," for events in the United Kingdom.

70. Likelihood of confusion is a basis for both cancellation and limitation of registered trademarks.⁹

71. Based on the foregoing, there is a likelihood of confusion between Goodwood's Registrations and the FOS Registration of "Festivals of Speed" requiring cancellation of Goodwood's registrations with the exception only of the limitation of Goodwood's First Registration, "Goodwood Festival of Speed" to use with reference to Goodwood's historic event in the United Kingdom.

Wherefore; Petitioner requests that Goodwood's Registrations be cancelled and or limited as set forth herein and for such other relief as deemed appropriate.

Dated: January 27, 2022

Respectfully submitted,
/s/Donald J. Schutz
Fla. Bar No. 382701
535 Central Avenue
St. Petersburg, FL 33701
727-823-3222
727-895-3222 Telefax
727-480-4425 Cell
don@lawus.com – Primary
donschutz@netscape.net – Secondary
Attorney for Petitioner Festivals of Speed, LLC

Certificate of Service: I hereby certify that the foregoing was served via email to Respondent's counsel of record, Craig S. Mende, cmende@fzlz.com, and Daniel M. Nuzzaci, dnuzzaci@fzlz.com, this 27th day of January, 2022.

/s/Donald J. Schutz

⁹ *Fred W. Amend Co. v. Am. Character Doll Co.*, 42 C.C.P.A. 983, 223 F.2d 277 (C.C.P.A. 1955); *Monster Energy Co. v. BeastUp Ltd. Liab. Co.*, 395 F. Supp. 3d 1334 (E.D. Cal. 2019).

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

FESTIVALS OF SPEED, LLC, A Florida
Limited Liability Company,
Petitioner,

CANCELLATION NO.
92078340

v.

THE GOODWOOD ESTATE COMPANY
PRIVATE LIMITED COMPANY UNITED KINGDOM,
Registrant.

**PETITIONER'S NOTICE OF FILING FIRST AMENDED PETITION AS ALTERNATIVE
TO BRIEF IN RESPONSE TO MOTION TO DISMISS**

Festivals of Speed, LLC, a Florida limited liability company, Petitioner, by and through undersigned counsel, now notifies the United States Trademark Trial and Appeal Board of its filing of its First Amended Petition as an alternative to the response to Respondent's Motion to Dismiss, and states:

1. Petitioner filed its original Petition on October 28, 2021.
2. Pursuant to agreed extensions, Respondent timely filed its Motion to Dismiss on January 7, 2022.
3. Per TBMP § 503.03, Petitioner may amend its complaint within 21 days after service of a motion to dismiss.
4. Simultaneously with the filing of this Notice, Petitioner has filed and served its First Amended Petition within the allowed 21 day period.
5. The filing of the First Amended Petition moots the Respondent's Motion to Dismiss, TBMP § 503.03, *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014).
6. Based on the foregoing, the Petitioner has filed its First Amended Petition as the alternative to the Brief in Response to the Motion to Dismiss.

Dated: January 27, 2022

Respectfully submitted,

/s/Donald J. Schutz

Fla. Bar No. 382701

535 Central Avenue

St. Petersburg, FL 33701

727-823-3222

727-895-3222 Telefax

727-480-4425 Cell

don@lawus.com – Primary

donschutz@netscape.net – Secondary

Attorney for Petitioner Festivals of Speed, LLC

Certificate of Service: I hereby certify that the foregoing was served via email to Respondent's counsel of record, Craig S. Mende, cmende@fzlz.com, and Daniel M. Nuzzaci, dnuzzaci@fzlz.com, this 27th day of January, 2022.

/s/Donald J. Schutz